

REMARKS

In response to the Final Office Action mailed April 7, 2006, the Applicant respectfully requests reconsideration.

Claims 1-20 were previously examined. By this Amendment, Applicant amends claims 1, 8 and 14 solely for clarification. As a result, claims 1-20 are pending for examination, of which claims 1, 8 and 14 are independent.

Applicant responds below to the arguments set forth in the Final Office Action only to the extent necessary to establish the patentability of the claims. Applicant's lack of response to any argument raised in the Office Action should not be construed as an acquiesce to the argument, but as Applicant's belief that traversing such argument is not necessary to overcome the current claim rejections and establish the patentability of the claims.

1. Telephone Interview

Applicant and Applicant's representative appreciate the courtesies extended by Examiner Dinh in granting and conducting a telephone interview on May 8, 2006, with Applicant's representative Daniel P. McLoughlin.

In Applicant's previous response, mailed January 5, 2006, Applicant noted that it was difficult to understand the basis of the §103(a) rejections set forth in the Office Action dated September 19, 2005. Applicant had the same difficulty understanding the basis of the §103(a) rejections set forth in the Final Office Action as well. Accordingly, Applicant requested the telephone interview seeking clarification of the §103(a) rejections.

The substance of this telephone interview is fully summarized herein.

2. This Amendment Should be Entered in the Application

During the telephone interview, Applicant suggested amending independent claims 1, 8 and 14 for clarification as shown above. Support for these amendments can be found throughout the specification, for example, on page 11, line 3 – page 12, line 10. Examiner Dinh agreed that the independent claims as amended would distinguish over the combination of U.S. Patent No. 6,820,204 (Desai) and U.S. Patent No. 6,608,832 (Forslow), and would thus overcome the rejections

of the independent claims under §103(a). However, the Examiner indicated that these amendments would introduce subject matter into the claims that would require additional search or consideration, and thus would not be considered unless a Request for Continued Examination (RCE) were filed. Applicant respectfully disagrees.

The amendments to claims 1, 8 and 14 do not introduce subject matter that requires additional search or consideration. Rather, the claim amendments merely clarify the term “mobility service” in each of these claims. For example, in claim 1, the following has been added: “wherein the mobility service is operative to provide mobility support for the first application in communicating with the second application when the mobile host moves between addresses”. This does not introduce subject matter that requires additional search and consideration, but merely clarifies the meaning of “mobility service” in the context of claim 1 itself and the specification (e.g., page 11, line 3 – page 12, line 10). That is, with respect to claim 1, the added language further clarifies the role of the mobility service in the steps of receiving, calling, establishing, setting up, obtaining, reestablishing and resetting that were already recited in claim 1 before the amendment. A person of reasonable skill in the art would have attributed this meaning to “mobility service” in claim 1 even without the amendment.

In view of the foregoing, the amendments to claims 1, 8 and 14 do not introduce subject matter that requires additional search and consideration. Accordingly, Applicant respectfully requests that the amendment be considered and entered, and the application be allowed for the reasons set forth below.

3. Claims 1-7 Patentably Distinguish Over Desai in View of Forslow

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Desai in view of Forslow. Applicant respectfully traverses this rejection.

Claim 1 has been amended as shown above to recite:

A computer-readable medium having computer-executable instructions for performing steps for a correspondent host to provide mobility support for communications with a mobile host, the steps comprising:

receiving, by a mobility service of the correspondent host, a request from a first application on the correspondent host to set up a communication connection with a second application on the mobile host, the mobility service being

implemented in an application programming interface (API) layer of an operating system of the correspondent host, **wherein the mobility service is operative to provide mobility support for the first application in communicating with the second application when the mobile host moves between addresses;**

calling, by the mobility service, a session establishment service of the correspondent host implementing a session establishment protocol to establish a session with the mobile host;

establishing, by the session establishment service, a session with the mobile host;

setting up, by the mobility service, a communication connection under a transport protocol for communications between the first and second applications;

obtaining, by the session establishment service, a notice through operation of the session establishment protocol that the mobile host has moved to a new address;

reestablishing, by the session establishment service, a session with the mobile host for the new address of the mobile host; and

resetting, by the mobility service, a communication connection for the new address of the mobile host.

As set forth in Applicant's previous response, the combination of Desai and Forslow is improper because, at the time of the invention, one of skill in the art would not have been motivated to combine Desai and Forslow as suggested in the Office Action. Further, even if the combination were proper, which it is not, claim 1 patentably distinguishes over the combination for at least the following reasons.

As the Examiner conceded during the telephone interview, the combination of Desai and Forslow does not teach or suggest all of the limitations recited in claim 1 as amended, in particular the limitation of "wherein the mobility service is operative to provide mobility support for the first application in communicating with the second application when the mobile host moves between addresses". During the telephone interview, Examiner Dinh explained that he believes that the applications ("personal e-mail, chat rooms, personal calendars, contact management and document management") described by Desai as being available to a network device 12a of the registered user 12 are mobility services because the network device 21a may be a mobile device (e.g., a personal digital assistant (PDA) or a wireless application protocol telephone (WAP)). (Col. 8, lines 35-51). As explained by Applicant, these applications are not "mobility services" in the context of claim

and the specification (see above), but merely applications that may run on mobile devices, which is altogether different. The Examiner disagreed.

Applicant then suggested making the clarifying amendment to claim 1 shown above. As agreed by the Examiner during the telephone interview, none of the applications listed above from Desai are a mobility service “operative to provide mobility support for the first application in communicating with the second application when the mobile host moves between address.” This limitation is simply not taught or suggested by Desai, and this deficiency is not remedied by Forslow. Thus, the combination of Desai and Forslow does not teach or suggest the “mobility service” recited in claim 1.

The combination of these references also does not disclose the “session establishment service” recited in claim 1, nor the steps of receiving, calling, establishing, setting up, obtaining, reestablishing, and resetting recited in claim 1, which each involve the mobility service and/or the session establishment service. Applicant did not discuss all of these limitations with the Examiner during the telephone interview, but primarily focused on the steps of receiving and calling. The Examiner indicated that he believes these steps are inherent (aside from the use of an API, for which the Examiner relies on Forslow) in Desai’s description of the information exchange system 10 selectively granting third parties access to stored profile data. (Col. 9, lines 1-17; Fig. 1). Applicant strongly disagrees, as neither of these steps (nor any of the remaining steps recited in claim 1) are inherent in this granting of access. Should the Examiner maintain this position in a future Office Action, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support his position that the steps of claim 1 are inherent characteristics that necessarily flow from the teaching of Desai (MPEP §2112; *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Final Office Action and the previous Office Action have failed to provide this basis in fact and/or technical reasoning. The same support must be provided for any other reference asserted to inherently teach any claim limitation.

In view of the foregoing, claim 1 patentably distinguishes over Desai and Forslow individually or in combination. Accordingly, Applicant respectfully requests that the rejection of claim 1 under Section 103(a) be withdrawn.

Claims 2-7 each depend from claim 1 and are patentable for at least the same reasons. Accordingly, Applicant respectfully requests that the rejections of these claims be withdrawn.

4. **Claims 8-13 Patentably Distinguish Over Desai in View of Forslow**

Claims 8-13 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Desai in view of Forslow. Applicant respectfully traverses this rejection.

For reasons set forth above and in Applicant's previous response, the combination of Desai and Forslow is improper. Further, even if the combination were proper, which it is not, claim 8 patentably distinguishes over the combination.

Claim 8 as amended recites:

"A computer-readable medium having computer-executable instructions for performing steps for a correspondent host to provide mobility support for communications between a first application on the correspondent host with a second application on a mobile host over an existing session and an existing communication connection, the steps comprising:

receiving, by a session establishment service of the correspondent host implementing a session establishment protocol, a notice through operation of the session establishment protocol that the mobile host has moved to a new address;

reestablishing, by the session establishment service, a session with the mobile host for the new address of the mobile host; and

resetting, by a mobility service, a communication connection for the new address of the mobile host for communications between the first and second applications, the mobility service being implemented in an application programming interface (API) layer of an operating system of the correspondent host,

wherein the mobility service is operative to provide mobility support for the communications between the first application and the second application when the mobile host moves between addresses."

For reasons that should be clear from the discussion of Desai and Forslow set above in Section 3, the combination of Desai and Forslow does not teach or suggest all of the limitations of the computer-readable medium recited in claim 8, in particular, the limitation of: "wherein the mobility service is operative to provide mobility support for the communications between the first application and the second application when the mobile host moves between addresses."

In view of the foregoing, claim 8 patentably distinguishes over the combination of Desai in view of Forslow. Accordingly, Applicant respectfully requests that the rejection of claim 8 under §103(a) be withdrawn.

Claims 9-13 each depend from claim 8 and are patentable for at least the same reasons. Accordingly, Applicant respectfully requests that the rejections of these claims be withdrawn.

5. **Claims 14-20 Patentably Distinguish Over Desai in View of Forslow**

Claim 14-20 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Desai in view of Forslow. Applicant respectfully traverses this rejection.

For the reasons set forth above and in Applicant's previous response, the combination of Desai and Forslow is improper. Further, even if the combination were proper, which it is not, claim 14 patentably distinguishes over the combination.

Claim 14 recites:

“A method for a correspondent host to provide mobility support for communications with a mobile host, comprising the steps of:
receiving, by a mobility service of the correspondent host, a request from a first application on the correspondent host to set up a communication connection with a second application on the mobile host, the mobility service being implemented in an application programming interface (API) layer of an operating system of the correspondent host, **wherein the mobility service is operative to provide mobility support for the first application in communicating with the second application when the mobile host moves between addresses;**
calling, by the mobility service, a session establishment service of the correspondent host implementing a session establishment protocol to establish a session with the mobile host;
establishing, by the session establishment service, a session with the mobile host;
setting up, by the mobility service, a communication connection under a transport protocol for communications between the first and second applications;
obtaining, by the session establishment service, a notice through operation of the session establishment protocol that the mobile host has moved to a new address;
reestablishing, by the session establishment service, a session with the mobile host for the new address of the mobile host; and
resetting, by the mobility service, a communication connection for the new address of the mobile host.”

For reasons that should be clear from the discussion of Desai and Forslow set forth above in Section 3, the combination of these references does not teach or suggest all of the limitations of the method recited in claim 14, in particular, the limitation of: "wherein the mobility service is operative to provide mobility support for the first application in communicating with the second application when the mobility host moves between addresses".

In view of the foregoing, claim 14 patentably distinguishes over Desai in view of Forslow. Accordingly, Applicant respectfully requests that the rejection of claim 14 under §103(a) be withdrawn.

Claims 15-20 each depend from claim 14 and are patentable for at least the same reasons. Accordingly, Applicant respectfully requests that the rejections of these claims be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

By: 

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